

12

REMARKS/ARGUMENTS

Reconsideration of the present application, as amended, is respectfully requested.

A. STATUS OF THE CLAIMS

As a result of the present amendment, claims 1-18 are again presented in the case for continued prosecution.

B. OBJECTIONS AND REJECTIONS UNDER 35 U.S.C. §112

The specification has been amended to correct the trademarked term as required and all informalities have been attended to. It is urged that the specification and claims are now in proper form and that all objections and rejections under 35 USC §112 can be removed.

C. REJECTIONS UNDER 35 U.S.C. § 102(e)

One page 3 of the Office Action, the Examiner has rejected the subject matter of claims 1-4, 6-13 and 15-18 as being anticipated under 35 USC 102(e) by commonly-assigned U.S. Patent No. 6,395,266 to Martinez (hereinafter the '266 patent). As the Examiner should appreciate, a rejection under 35 U.S.C. § 102(e) requires that all of the elements of the rejected claims be found within the cited reference.

As pointed out on page 7 of the application, certain advantages are achieved by the present invention's use of the extender (or spacer) moieties described herein between the polymer residue ends and the parent therapeutic molecules. One of the chief advantages of the present invention is that the spacer group allows the prodrugs to have a more predictable degree of loading. The extender groups of formula (I) correspond to the groups identified as k1 through k6. For example, in preferred embodiments, such as those defined by allowed claim 14, the spacer group is ethylene oxide. As a result of the amendment to the claims presented herein, k1-k6 are always present in formula (I). The possibility of these groups being absent, i.e. k1-k6 equal zero as per the application as filed, has been removed from the claims.

The '266 patent discloses similar branched polymer platforms but does not describe the bridging or spacer groups defined herein. It is respectfully submitted that the claims are not

13

anticipated by the '266 patent. Since the spacer groups are not taught in the '266 patent, Applicants respectfully traverse the Examiner's position that the above-mentioned claims are anticipated by the '266 patent. It is also further urged that the reference does not disclose or suggest the claimed methods of preparing the polymer transport systems or methods of treatment. Reconsideration and removal of the rejection is therefore respectfully requested.

D. FEES

This response is being filed with a Petition for a Two Month Extension of Time and credit card authorization to charge the required fee. No further fee is believed to be due. If, on the other hand, it is determined that any further fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to deposit account 02-2275. Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

F. CONCLUSION

In view of the actions taken and arguments presented, it is respectfully submitted that each and every one of the matters raised by the Examiner have been addressed by the present amendment and that the present application is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

MUSERLIAN, LUCAS & MERCANTI, LLP

By: 

Michael N. Mercanti
Registration No. 33,966

MUSERLIAN, LUCAS & MERCANTI, LLP
475 Park Avenue South
New York, New York 10016
Phone: 212-661-8000
Fax: 212-661-8002

13